Atty. Docket No. YO-999-567
(590.003)

REMARKS

Applicants and the undersigned are most grateful for the time and effort accorded to the instant application by the Examiner.

In the Office Action dated February 4, 2005, Claims 1, 3-6, 8-23 and 25-31 were rejected and the rejection made final. In addition, Claims 8 and 13 were objected to for minor informalities. In response to the Office Action, Applicants have filed herewith a Request for Continued Examination and have amended Claims 1, 8, 13, 20, and 31. Of the rejected claims, Claims 1, 20, and 31 are independent claims; the remaining claims being dependent. Specifically, in response to the Examiner's objections, Claim 8 has been amended so that it is now dependent upon Claim 1; whereas, Claim 13 has been amended to correct a typographical error, namely, "pringer" has been corrected to read "printer." Furthermore, Claims 6 and 23 have been cancelled and their substance incorporated into independent Claims 1, 20, and 31. The specification has also been amended to correct minor typographical errors in the paragraph contained on page 5. Applicants intend no change in the scope of the claims by the changes made by this amendment. It should also be noted these amendments are not in acquiescence of the Office's position on the allowability of the claims, but merely to expedite prosecution. The Office is respectfully requested to reconsider the rejections presented in the outstanding Office Action in light of the following remarks.

Claims 1, 3-5, 20-22 and 31 stand rejected under 35 U.S.C. § 102 as being anticipated by Pleso. Reconsideration and withdrawal of this rejection is respectfully requested.

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As best understood, Pleso appears to be directed to a method for downloading a

device driver integrated with the device to a computing operating system. (Col. 1, lines 9-

12) In particular, Pleso apparently uses a hardware device capable of integrating its

device driver within memory coupled to the device itself. Upon coupling the device with

a computing system and after recognition of the device as one requiring a device driver

by the operating system, the device is able to download its driver to the operating system

of the computer. Thereby alleviating the need to install the device driver independently of

the device itself. In addition, Pleso appears to appreciate that instead of integrating the

device driver with the device, the device could instead integrate information directing an

operating system to an Internet location where the appropriate driver could be

downloaded to the computer operating system. (Col. 13, lines 26-33) After the device

driver is downloaded to the computer operating system, the computing system can then

communicate with the device through the installed driver, thus avoiding manual

installation using a separate disk or CD-ROM.

The downloading of a device driver to the operating system of a computing

system in Pleso stands in stark contrast to the present invention. As discussed in the

specification, the invention claimed herein is not only capable of providing a computer

operating system with the network location where the latest driver download can be

found and downloaded to the computer operating system, but also contains interface logic

that enables the device itself to, additionally, download the device driver from a network

location into its own memory. (Page 6, lines 14 – Page 7, line 2; Page 7, lines 14-18)

Claim 1 has been rewritten to recite, *inter alia*, wherein said interface logic is

further adapted to assist a computer operating system in obtaining a <u>copy of the device</u>

driver for installation in said device. (emphasis added) Similar language also appears in

Claims 20 and 31.

It is, therefore, respectfully submitted that Pleso falls short of the present

invention in that, *inter alia*, it does not disclose a device capable of downloading to itself

a device driver from a network location. As the Examiner is assuredly aware, at the very

least, "[a]nticipation requires the disclosure in a single prior art reference of each element

of the claim under consideration." *W.L. Gore & Associates, Inc. v. Garlock*, 721 F.2d

1540, 1554 (Fed.Cir. 1983); *see also In re Marshall*, 198 U.S.P.Q. 344, 346 (C.C.P.A.

1978). For these reasons, Pleso does not anticipate the Claims under 35 U.S.C. § 102.

Claims 6, 8-19 and 23-30 stand rejected under 35 U.S.C. § 103(a) as obvious over

Pleso in view of Chiles et al. Specifically, the Office asserts:

> [P]leso teaches the limitations of the claims, including means to update
> the self-descriptive information in the device, and providing a network
> location where said information may be obtained [col. 13, lines 33-35].
> However, Pleso does not teach a method of updating said information
> whereby the method further comprises version upgrades and error
> handling.
> Chiles teaches the method of updating the identification information
> and device drivers substantially as claimed... .
> [I]t would have been obvious to a person of ordinary skill in the art to
> employ the update method as taught by Chiles. One of ordinary skill in
> the art would have been motivated to do so[, so] that the identification
> information and device drivers stored on the device as taught by Pleso can
> be updated... .
> Moreover, the update means taught by Chiles would improve the
> flexibility of Pleso because it allowed for variations within the update
> process for the self-descriptive information of a device.

For the following reasons, reconsideration and withdrawal of the present rejections are

hereby respectfully requested.

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Where references can be combined with one another to produce the claimed invention, a 35 U.S.C. § 103(a) obviousness rejection is proper if the combined cited references provide both the motivation to combine the references and an expectation of success. *See Pro-Mold & Tool Company v. Great Lakes Plastics, Inc.*, 75 F.3rd 1568 (Fed.Cir. 1996). The Court of Appeals for the Federal Circuit stated, "[P]rior art referenced in combination do not make an invention obvious unless something in the prior art references would suggest the advantage to be derived from combing their teachings." *In re Imperato*, 179 USPQ 730 (C.C.P.A. 1973). In this instance the combined references neither produce the claimed invention nor do they provide a motivation or an expectation of success for so doing. Therefore, the claimed invention is patentable over the combined references and the state of the art.

Chiles et al. does not overcome the deficiencies of Pleso set forth above, i.e., the failure of Pleso to teach a device capable of downloading a device driver to the device itself. Chiles et al. appears to teach a technique for automatically updating software stored on a client computer within a networked client-server environment, thereby allowing the updating of software located on numerous client computers in the network through the central network server. (Col. 1, lines 8-17) The method of Chiles et al. focuses on a process whereby a client computer in a networked environment is capable of downloading an update script from the network server. The script will direct the client computer to update its software using update files contained on the network server, or alternatively, from files contained on the Internet. If the update files are contained on the network server, then the update can proceed automatically. If, however, the client computer is directed to the Internet for its update files a manual process of installation is

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required to be performed by the client computer user. Upon completion, the Chiles et al. invention appears to record the fact that an update has occurred and schedules a new date to check the script contained on the network server for future update commands. The purpose of Chiles et al. is to enable the process of updating software on numerous client computers through one centrally located server cache, where the appropriate updates, or the location of such updates, can be maintained by the network administrator on the network server.

Combining Pleso and Chiles et al. results in a process where, as a result of the installation of a device to a computing system, a client computer (in a networked environment) would download a copy of the device's driver from the device. The copy of the device's driver downloaded from the device would then be stored in the client computer's operating system and, subsequently, updated through the client-server script process as described in Chiles et al. Thus, the combination of Pleso and Chiles et al. does not teach or suggest the presently claimed invention.
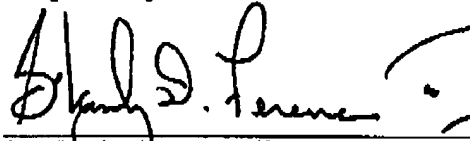
Furthermore, Pleso in view of Chiles et al. provides no motivation for the combination of these two references. This is evident, because if a device such as that described in Pleso were to be coupled to a computing system such as that contemplated in Chiles et al., i.e., a client-server network environment, there would be no need to have a device capable of downloading and integrating to itself its device driver. The device in Pleso would download its driver (or indicate where to retrieve such a download) directly into the client computer operating system, which in view of Chiles et al. would be kept up-to-date via the server script and client-server network relationship described above.

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Neither reference, nor both taken in combination, provide the motivation for a device that is capable of downloading its device driver to itself.

Since the prerequisite motivation needed to find obviousness is lacking and the claimed invention is not the same as that produced through the combination of the references cited, the claimed invention is not obvious under 35 U.S.C. § 103(a).

In view of the foregoing, it is respectfully submitted that Claims 1, 20, and 31 are fully distinguishable over the applied art and are, thus, presently in condition for allowance. By virtue of their dependence on what is believed to be independent Claims 1 and 20, it is respectfully submitted that Claims 3-5, 8-19, 21-22, and 25-30 are also presently allowable. Notice to the effect is hereby earnestly solicited.

Respectfully submitted,

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